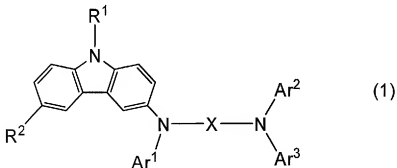


As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

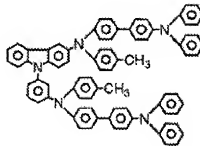
The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. Independent claims 1-3 recite a carbazole derivative represented by a general formula (1) (shown below),



wherein R<sup>1</sup> represents any one of hydrogen, an alkyl group having 1 to 6 carbon atoms, an aryl group having 6 to 25 carbon atoms, a heteroaryl group having 5 to 9 carbon atoms, an arylalkyl group and an acyl group having 1 to 7 carbon atoms. Similar subject matter is recited in independent claims 7-9, 13-15 and 19-21, with respect to a

carbazole derivative represented by general formulae (3), (5) and (103), respectively. For the reasons provided below, Kitahora, Aoki, Matsumoto and Kawamura, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

The Official Action asserts that "according to the general formula as disclosed by Kitahora et al.,  $Ar_3 = Ar_4 = Ar_5 =$  phenyl group ([0034]) such that the total number of carbon atoms is 18 for  $R_1$ " (page 2, Paper No. 20100204). The Official Action further asserts that in Kitahora "discloses an amino compound ... where one such example compound is disclosed [reproduced at right]: ((19), page 7 such that  $R^1 =$  aryl group having 25 carbon atoms (substituted phenyl group),  $Ar^1 =$  aryl group having 7 carbon atoms (substituted phenyl group),  $Ar^2 = Ar^3 =$  aryl group having 6 carbon atoms ..." (page 7, Id.). The Applicant respectfully disagrees and traverses the assertions of the Official Action.



It is respectfully submitted that compound 19 of Kitahora, on which the Official Action appears to rely, only potentially teaches that an alleged  $R^1$  has 37 carbon atoms, not 18 or 25 as the Official Action asserts. Specifically, the Applicant notes that compound 19 of Kitahora,  $Ar_3 = C_6H_4$ ,  $Ar_4 = C_6H_4-CH_3$  and  $Ar_5 = C_6H_4-C_6H_4-NPh_2$ . Accordingly, the substituent group that the Official Action appears to correspond with  $R_1$  has a total of 37 carbon atoms. Aoki and Matsumoto do not cure the deficiencies of Kitahora. Therefore, the Applicant respectfully submits that Kitahora, either alone or in combination with Aoki, Matsumoto and Kawamura, does not teach or suggest that  $R^1$  represents any one of hydrogen, an alkyl group having 1 to 6 carbon atoms, an aryl group having 6 to 25 carbon atoms, a heteroaryl group having 5 to 9 carbon atoms, an arylalkyl group and an acyl group having 1 to 7 carbon atoms.


Since Kitahora, Aoki, Matsumoto and Kawamura, either alone or in combination, do not teach or suggest all the claim limitations, a *prima facie* case of obviousness

cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c) and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,

  
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